

REMARKS

It is understood that this application has received a final rejection, and Applicants do not have a right to amend the claims at this time. However, it is believed that the remaining rejections in this application can be most efficiently handled via the proposed amendments outlined in this communication. Therefore, reconsideration of this application is respectfully requested in view of the above amendments and following remarks. The undersigned attorney wishes to thank the Examiner for his time during our brief telephonic discussion of the proposed amendments to this application on April 27, 2006.

In the current listing of claims, the pending claims are: 2-15, 17-19, 25 and 30. In the pending claims, Claims 2, 15 and 30 are currently amended.

No new matter has been added to this application by the amendments noted above.

Claim Rejection Under 35 USC § 112, 2nd paragraph

Claims 1-15, 17-19, 21 and 25 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated:

i) In claims 1, 2 and 15, the phrase “and pharmaceutically acceptable salts, esters and tautomers thereof” is inappropriate because this phrase requires all of them to be present at the same time in the claims. That is, while Applicants intend a compound or its salt, the claims require a compound and its salt to be present. The phrase could be rewritten as, for example, “or a pharmaceutically acceptable salt thereof” or use the Markush language “selected from the group consisting of a compound and salt.”

Claim 1 was cancelled in the previous response. However, claims 2, 15 and 30 did contain the “and pharmaceutically acceptable salts, . . .” phraseology. Claim 2 has been amended to recite “or a pharmaceutically acceptable salt, ester or tautomer thereof.” Claims 15 and 30 have been put in proper Markush format by amending the preambles to read: “selected from the group consisting of” and maintaining the “and pharmaceutically acceptable salts, . . .” phraseology near the end of each claim. Claim 30 has also been amended to be in independent form. These amendments address the Examiner’s concerns, but do not alter the scope of the claims, nor do they add new matter to the claims.

The Examiner also stated:

The kinds of “esters” of the compound of formula I are unclear...

Applicants first state that $R^2=COOR^3$. R^3 is defined as H, phenyl or alkyl. That is, phenyl esters and alkyl esters are already claimed. The problem is what else is intended. That what is positively recited in the claims is well understood. It is unclear which other esters Applicants intend to include into the claims. Regarding claim 15, compound (20) and compound (12) of claim 30 which contain a carboxyphenyl group, it is unclear what is esterified or what kind of an ester is being formed.

Applicants also point to page 27, line 29-30 for additional description. However, there was no description found here.

Pharmaceutically acceptable esters of compounds having free carboxylic acid groups within the scope of Formula I are clearly intended to be within the scope of the claimed invention, for example by inclusion of the phrase “and the *pharmaceutically acceptable salts, esters and tautomers thereof*” in the claims as filed and in the specification at page 29, lines 14-18. Applicants apologize for the erroneous reference to page 27, line 29-30 in their previous response. Esters of compounds within the scope of Formula I are possible whenever a free carboxylic acid group is present. For example, compounds of this invention defined in claim 2 can contain a $-COOH$ group when $R^2 = -COOR^3$; $R^6 = -COOR^3$ or a group substituted with $-COOR^3$; or $R^7 = -COOR^3$ or a group substituted with $-COOR^3$; wherein $R^3 = H$. In claim 15, several named compounds contain a free carboxylic acid group, e.g., compounds (9), (20), (26)-(28) and (31). Similarly there are free carboxylic acid groups in some of the named compounds of claim 30, e.g., compounds (12) and (15).

As noted by the Examiner, R^3 is defined not only as $-H$ but also as $-C_{1-6}$ alkyl or phenyl. Therefore, Applicants agree with the Examiner that phenyl esters and C_{1-6} alkyl esters are already encompassed as pharmaceutically acceptable esters within the scope of Formula I. However, at page 29, lines 14-16 of the specification, the application further states:

“Examples of pharmaceutically acceptable esters include, but are not limited to, $-C_{1-4}$ alkyl and $-C_{1-4}$ alkyl substituted with phenyl-, dimethylamino-, and acetylamino.”

Therefore, in addition to the phenyl ester and alkyl ester as defined by $-COOR^3$, it was also intended that the substituted $-C_{1-4}$ alkyl group noted in the excerpt above be included as a pharmaceutically acceptable ester within the scope of the invention. Therefore, claims 2, 15 and 30 have been amended to clearly recite that “(a) a phenyl ester, (b) a $-C_{1-6}$ alkyl ester and (c) a substituted C_{1-4} alkyl ester wherein the substituent is selected from the group consisting of phenyl-, dimethylamino- and acetylamino-” are all pharmaceutically acceptable esters within the scope of the invention. This amendment to the claims is supported, for example, at page 29,

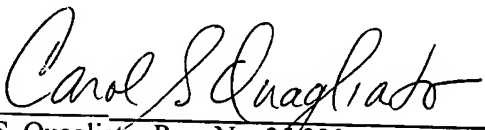
lines 14-16 of the specification as well as in the definition of R³ as originally filed, and does not add new matter to the application.

It is believed that the amendments described above address all the Examiner's reasons for rejection, and that the current claims particularly point out and distinctly claim the subject matter which the applicants regard as their invention. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, 2nd paragraph against claims 2, 15 and 30.

The Examiner stated that claims 3-14, 17-19 and 25 would be allowable if re-written to overcome the rejections under 35 USC 112, 2nd paragraph and to contain all of the limitations of the base claim and any intervening claims. These claims all ultimately trace their dependencies back to base claim 2. For the above-discussed reasons, amended claim 2 is believed to meet the requirements of 35 U.S.C. § 112, 2nd paragraph. Since claims 3-14, 17-19 and 25 depend from and contain all the limitations of base claim 2, they likewise are believed to meet the requirements of 35 U.S.C. § 112, 2nd paragraph. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, 2nd paragraph against claims 3-14, 17-19 and 25.

For the foregoing reasons, Applicants believe that the instant application is in condition for allowance, and an early notification thereof is earnestly solicited. If the Examiner has further questions or concerns regarding this application, he is invited to telephone the undersigned attorney at the number below.

Respectfully submitted,

By: 
Carol S. Quagliato, Reg. No. 36,330
Attorney for Applicants
MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel.: (732) 594-3809

Date: May 1, 2006